

Appl. No. 09/824,454
Atty. Docket No. 8047
Amdt. dated June 27, 2003
Reply to Office Action of January 29, 2003
Customer No. 27752

REMARKS

Claims 1-5 are pending in the present application. Applicant confirms the election to prosecute Claims 1-6; Claim 7 has been cancelled. Claim 1 has been amended to incorporate the subject matter of Claim 6, which has been cancelled. The amendment to Claim 1 does not introduce new matter. No additional claims fee is believed to be due.

Rejection Under 35 USC 103(a) Over Reader

Claims 1-6 were rejected under 35 USC 103(a) as being unpatentable over Reader et al. (5,883,026). Applicant respectfully traverses this rejection. A prima facie case of obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Applicant respectfully submits that a prima facie case has not been established because there is no teaching, suggestion, or motivation to modify the reference found in either the reference itself or in the knowledge generally available to one of ordinary skill in the art.

"The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)." MPEP 2142. Applicant respectfully submits that Reader fails to expressly or impliedly suggest the desirability of the modification suggested in the Office Action.

The Office Action recognized that Reader fails to teach the use of discrete bond sites. The Office Action asserted that "it would have been obvious to a person having ordinary skill in the art to laminate the layers with discrete bonds." Paper 2, page 2. The Office Action states that "the skilled artisan would have been motivated to utilize discrete bond sites by the desire to achieve sufficient bonding without sacrificing softness, which occurs with total bonding." Paper 2, page 2.

Applicant avers that it would not have been obvious to modify Reader to utilize discrete bond sites. Reader discloses that "all or a portion of the layers may be bound to adjacent layers." Col. 3, lines 34-35. Reader also discloses:

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"the layers of the body portion will be laminated to one another such that there will be little tendency to separate or tear, particularly at the edges of the body portion. In some embodiments, it may be desired to employ at least one binding strip ... along all the edge portions of the mask to reduce any tendency which may exist for the layers to separate or the body portion to tear.... The edge portions of the mask are then placed within the fold [of the binding strip] and the binding strip either sewn or adhesively secured to the edge portions."

Col. 7, lines 43-55. Reader describes all or a portion of the layers being bound to adjacent layers as a laminate. The portions of Reader's layers that are bound together are the edge portions bound with binding strips to increase the strength of the face mask rather than to increase the softness. Reader's description of the facemask construction focuses on increasing the strength of the mask to increase the protection provided to the user. There is no teaching that safety and protection should be sacrificed to increase the softness of the material.

Applicant submits that the construction of a multi-layer web depends on the balancing of several factors. Furthermore, the binding utilized in forming a multi-layer web will affect several important properties and characteristics of the web. Reader is directed to a facemask to protect doctors and others from objects contact their face. Principally, Reader is directed toward protecting doctors from blood-borne pathogens. In such an application, the properties of the web that can be impacted by modifying the binding are critically important, such as the strength of the web and the strike-through properties as discussed in Reader. Accordingly, Applicant avers that it would not be obvious to modify the binding technique taught in Reader in the interest of promoting softness. Applicant avers that even if it would be obvious to utilize discrete bonds to increase softness, Reader fails to indicate that softness is desirable in its facemask. Accordingly, there is no motivation or suggestion within Reader to modify it to incorporate discrete bond sites to increase softness of the face mask

Reader fails to disclose, teach, or suggest utilizing discrete bond sites as required by Claims 1-5. Therefore, the Office Action's required motivation to modify Reader to utilize discrete bond sites could only come from reliance on knowledge of ordinary skill in the art. Section 2144.03 of the MPEP discusses rejections that rely on knowledge of ordinary skill in the art for an obviousness conclusion. Specifically, it says:

"Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.... It would not be appropriate for the examiner to take official notice of facts without citing a